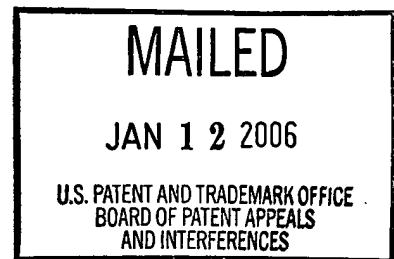


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL HEATON
and WILLIAM P. BUCKNER

Application No. 09/915,805



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on October 4, 2005 . A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

APPEAL BRIEF

A review of the file indicates that on March 14, 2005, appellants filed an Appeal Brief under the rules set forth in 37 CFR § 41.37(c). However, the Appeal Brief filed on March 14, 2005, does not fully comply with the new rules under 37 CFR § 41.37(c).

37 CFR § 41.37(c) states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) ***Evidence appendix.*** An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) ***Related proceedings appendix.*** An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief filed February 17, 2005:

- 1) "Evidence Appendix," as set forth in 37 CFR § 41.37(c)(1)(ix).
- 2) "Related Proceedings Appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

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It is required that a supplemental Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules, please see the web page entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at: <http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

REQUEST FOR REFUND

On June 6, 2003, appellant filed an Appeal Brief and the required fee. Thereafter prosecution was reopened. On March 14, 2005, appellant filed a second Appeal Brief and the required fee. On April 5, 2005, appellant filed a request for refund of the second Appeal Brief fee paid on March 14, 2005. Today appellant has received no correspondence on his request for refund.

EXAMINER'S ANSWER

The Examiner's Answer mailed July 22, 2005, introduces a new ground of rejection to Claims 16-21 under 35 U.S.C. 102(b) as being anticipated by Messersmith.

Any new ground of rejection made by an examiner in an examiner's answer must be approved by a Technology Center (TC) Director or designee (see MPEP 1207.05). SPE Bucci has not been authorized as a designee.

Accordingly, it is

ORDERED that the application is returned to examining corps for the examiner to resolve the following issue:

- 1) hold the Appeal Brief filed on March 14, 2005, defective;

2) to notify appellants to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37;

3) address appellant's request for refund dated April 5, 2005;

4) to vacate the Examiner's Answer mailed July 22, 2005, to consider the supplemental Appeal Brief; and submit a revised Examiner's Answer in accordance with the new rules effective September 13, 2004, wherein the new ground of rejection has been approved by a Technology Center Director or his designee in compliance with 37 CFR § 41.39; and

5) for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal (i.e. abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES



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